## III. Remarks

Claims 12-30 were previously pending. No claims have been canceled or added. Applicants request reconsideration of pending claims 12-30 in light of the above amendments and the following remarks.

**§102 Rejections**

**Claims 22, 23, 28, and 30** stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0039384 A1 to Boehm, Jr. et al. ("the Boehm application").

The PTO provides in MPEP § 2131 that

> *"[t]o anticipate a claim, the reference must teach every element of the claim...."*

Therefore, to sustain the rejection of these claims the Boehm application must teach all of the claimed elements of each claim.

With respect to independent claim 22, the Boehm application at least fails to teach, "rotating the connecting member to move the first vertebra and the second vertebra relative to one another to reduce the spondylolisthesis therebetween." The Office Action asserts that the "Boehm [application] then discloses the connecting member is coupled to the screws and rotated to move the vertebrae, paragraphs 56, 59." However, it is clear that the noted paragraphs of the Boehm Application describe a method and associated apparatus (rod holder system 100 and rod-guiding tool 120) for attaching the rod 66 to the screw head 60 of the bone screw 54. The rod 66 of the Boehm application is not rotated to move the vertebrae relative to one another as required. In that regard, the Boehm application does not make a single reference to moving the vertebrae with rod 66. It is clear that the Boehm application simply does not disclose rotating a connecting member to reduce the spondylolisthesis between first and second vertebrae. Further, the Boehm application discloses placing screws 54 within the pedicles. The Boehm application does not appear to disclose "engaging a first member with a sidewall of the first vertebra" as required by claim 22. For at least these reasons the Boehm application fails to teach all of the claimed elements of independent claim 22. Claims 23, 28, and 30 depend from and further limit

claim 22. Thus, for at least these reasons Applicants request that the §102 rejection of claims 22, 23, 28, and 30 over the Boehm application be withdrawn.

**Claims 22, 23, 28, and 30** also stand rejected under 35 U.S.C. § 102(a) as being anticipated by EP 1222900 to Nohara et al. ("the Nohara patent"). With respect to independent claim 22, the Nohara patent at least fails to teach, "rotating the connecting member to move the first vertebra and the second vertebra relative to one another to reduce the spondylolisthesis therebetween." The Nohara patent simply does not disclose rotating the rod member 1 "to move the first vertebra and the second vertebra relative to one another to reduce the spondylolisthesis therebetween" as recited. The Nohara patent discloses axially moving the rod member 1 and rotating the rod member with the same tool prior to integrally fixing the rod member to the screws 5. Col. 3, Lines 2-29. In that regard, the Nohara patent discloses rotating the rod member 1 so that the curve of the rod member corresponds to the curve of the backbone. Col. 3, Lines 8-13. However, the Nohara patent does not mention or describe moving the vertebrae by rotation of the rod member 1. Nohara simply does not disclose rotating the rod member 1 to move the vertebrae relative to one another.

In response to Applicants' previous arguments, the Examiner noted that "when fixation rods are used they are intended to hold the vertebrae in adjusted positions after re-aligning or the surgeon has accomplished correction procedures. Inherently, some rotation about the screw takes place to move the rod and affix with the second screw." These comments, however, seem to support the Applicants assertion that the Nohara patent fails to teach all of the recited elements of claim 22. For example, if "fixation rods are used ... **after** re-aligning or the surgeon has accomplished correction procedures," then it is clear that the fixation rods were not used to move the vertebrae relative to one another to reduce sponylolisthesis as required. Further, even assuming *arguendo* that "some rotation about the screw takes place to move the rod and affix with the second screw," there is no indication that this rotation would cause the vertebrae to move with respect to one another to reduce spondylolisthesis.

Thus, for at least these reasons the Nohara patent fails to disclose all of the claimed elements of independent claim 22. Claims 23, 28, and 30 depend from and further limit claim 22. Thus, for at least these reasons Applicants request that the §102 rejection of claims 22, 23, 28, and 30 over the Nohara patent be withdrawn.

**§103 Rejections**

**Claims 12-15, 17, 20-24, and 26-30** stand rejected, in the alternative, under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,964,665 to Thomas et al. ("the Thomas patent") in view of U.S. Patent No. 4,554,914 to Kapp et al. ("the Kapp patent").

The PTO provides in MPEP §2131 that

> "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness."

The Examiner clearly cannot, using the Thomas and Kapp patents, establish a prima facie case of obviousness in connection to claims 12-15, 17, 20-24, and 26-30 for at least the following reasons.

35 U.S.C. §103(a) provides, in part, that:

> "A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time of the invention was made to a person having ordinary skill in the art . . ." (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

However, even when combined the Thomas and Kapp patents at least fail to disclose "applying a rotating force to the connecting member to rotate the first and second vertebrae relative to one another" as recited in claim 12. Again, similar to the Boehm application and the Nohara patent discussed above, the Thomas patent discloses using fixation hardware such as rods 50 "[o]nce the surgeon has manipulated the vertebral bodies into the proper, or desired, alignment." Col. 6, Lines 63-67. The Thomas patent simply does not disclose applying a

rotating force to rods 50 to rotate the vertebrae relative to one another. Similarly, the Kapp patent fails to disclose applying a rotating force to a connecting member to rotate first and second vertebrae. Further, neither of the Thomas and Kapp patents appears to disclose "laterally inserting a first insertion member into the first vertebra such that the first insertion member does not extend within the intervertebral space" or "laterally inserting a second insertion member into the second vertebra." Accordingly, even when combined the Thomas and Kapp patents fail to disclose all of the recited elements of independent claim 12. Claims 13-15, 17, 20, and 21 depend from and further limit claim 12. Thus, for at least these reasons Applicants request that the §103 rejection of claims 12-15, 17, 20, and 21 over the Thomas and Kapp patents be withdrawn.

Similarly, with respect to independent claim 22, even when combined the Thomas and Kapp patents fail to disclose "rotating the connecting member to move the first vertebra and the second vertebra relative to one another to reduce the spondylolisthesis therebetween." Also, the Thomas and Kapp patents do not appear to disclose "engaging a first member with a sidewall of the first vertebra" as required by claim 22. Claims 23, 24, and 26-30 depend from and further limit claim 22. Thus, for at least these reasons Applicants request that the §103 rejection of claims 22-24 and 26-30 over the Thomas and Kapp patents be withdrawn.

**Claims 18 and 19** stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Thomas patent in view of the Kapp patent as applied to claim 17, in further view of U.S. Patent No. 6,030,389 to Wagner et al. ("the Wagner patent"). However, as discussed above even when combined the Thomas and Kapp patents fail to disclose all of the recited elements of claim 12 from which claims 18 and 19 depend. The Wagner patent does not affect this deficiency. Accordingly, for at least the same reasons the Thomas, Kapp, and Wagner patents fail to disclose all of the limitations of claims 18 and 19. Therefore, Applicants request that the §103 rejection of claims 18 and 19 over the Thomas, Kapp, and Wagner patents be withdrawn.

**Claims 14-16 and 25** stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Thomas patent in view of the Kapp patent as applied to claim 13 and 24, in further view of U.S. Patent No. 5,314,477 to Marnay ("the Marnay patent"). However, as discussed above even when combined the Thomas and Kapp patents fail to disclose all of the recited elements of

claims 12 and 22 from which claims 14-16 and 25 depend. The Marnay patent does not affect this deficiency. Accordingly, for at least the same reasons the Thomas, Kapp, and Marnay patents fail to disclose all of the limitations of claims 14-16 and 25. Therefore, Applicants request that the §103 rejection of claims 14-16 and 25 over the Thomas, Kapp, and Marnay patents be withdrawn.

## IV. Conclusion

It is believed that all matters set forth in the Office Action have been addressed and that all pending claims are in condition for allowance. Accordingly, Applicants request an early indication of allowance of the pending claims. Should the Examiner have any questions, please contact the Applicants' undersigned representative at the number below.

Respectfully submitted,

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